

SW



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,092	05/22/2001	Donald R. Glover	7590.24US01	9012
23552	7590	12/23/2003		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER				
BOTTORFF, CHRISTOPHER				
ART UNIT		PAPER NUMBER		
3618				

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,092

Applicant(s)

GLOVER, DONALD R.

Examiner

Christopher Bottorff

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 and 13-17 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed October 10, 2003 has been entered. Claims 1-3, 6-11, and 13-22 are pending.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the handles on the wheeled items/scooters, as defined in claims 18-22, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamson US 4,458,906 alone.

Lamson discloses a toy sled having a body 19, 21, 23 and a wheeled item in the form of a floor scooter 12 with four caster wheels 16 and 18 connected to a rectangular

Art Unit: 3618

base piece 20. The body includes a top surface adapted for receiving a plurality of riders and a bottom surface comprising an engagement recess adapted for receiving the wheeled item. An attachment mechanism 37 removably secures the wheeled item in the engagement recesses. Also, the body defines a handle formed by a first side edge of the body such that the handle is generally planar with the top and the bottom surface. See Figures 1-3; column 2, lines 48-58; and column 3, lines 3-9.

The base piece 20 of the wheeled item includes a first side and a second side. The four wheels 16 and 18 are rotatably connected to the first side of the base piece and the first side of the base piece is positioned between the four wheels and the second side of the base piece. The second side of the base piece is secured to the body so that the four wheels extend away from the body. See Figures 2 and 3.

In addition, first and second attachment mechanism receptacles 34 are provided in the bottom surface of the body and they are longitudinally aligned. The attachment mechanism 37 removably secures the scooter to the recess 34 using the attachment mechanisms. See column 3, lines 11-13.

The body further defines a second handle formed by the forward edge of the body such that the handle is generally planar with the top and the bottom surface. A handle formed by the second side edge of the body is planar to the body and, along with the handle formed by the first side edge of the body, establishes two handles extending along the length of the body. Also, the attachment mechanism 37 is a bolt, and the body is formed of polyethylene. See Figures 1 and 2 and column 3, lines 3-5.

Lamson does not disclose that the rectangular shape of the wheeled item/scooter is specifically a square. However, the claimed shape is not disclosed as being critical. In fact, on line 39 of page 6 through line 1 of page 7 of the specification Applicant states that the sled "can be shaped and sized as desired" and that the sled "can be essentially any shape and size".

It is well settled that changes in shape are a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration claimed is significant. See *In re Dailey* 149 USPQ 47 (CCPA 1966). Changing the shape of the scooter of Lamson from a rectangle to a square would have been obvious to one of ordinary skill in the art at the time the invention was made in order to reduce the material required to manufacture the scooter.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamson US 4,458,906 in view of Null et al. US 5,947,495.

The sled of Lamson only utilizes one wheeled item arranged in the recess. Lamson does not disclose a plurality of wheeled items, as claimed. However, Null et al. teaches that the practice of providing a sled with a plurality of wheeled items 50 and 60 was old and well known in the art at the time the invention was made. See Figures 1 and 2. From the teachings of Null et al., providing the sled of Lamson with a plurality of wheeled items would have been obvious to one of ordinary skill in the art at the time the invention was made. This would provide the sled with greater stability and support.

Also, providing the sled of Lamson with a plurality of wheeled items represents an obvious duplication of the parts of Lamson that would not provide a new and unexpected result. See *In re Harza* 124 USPQ 178 (CCPA 1960). Providing two scooters would have been obvious to one of ordinary skill in the art at the time the invention was made in order to offer greater stability and support to the body.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamson US 4,458,906 in view of Bergsland US 3,705,730.

Lamson does not disclose a connector at the first end of the body and a connector receptor at the second end of the body. However, Bergsland teaches that the practice of providing a toy sled with a connector 5 at a first end of a body and a connector receptor 3 at a second end of the body was old and well known in the art at the time the invention was made. See Figures 1 and 2. From the teaching of Bergsland, providing the sled of Lamson with a connector at the first end of the body and a connector receptacle at the second end of the body would have been obvious to one of ordinary skill in the art at the time the invention was made. This would allow the sled to be formed into a train with other sleds.

Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamson US 4,458,906 in view of Karashima US 6,095,348.

Lamson does not disclose that the wheeled item/scooter has opposing handles and does not disclose the specific dimensions of claims 18, 20, and 21.

However, Karashima teaches that the practice of providing wheeled items/scooters 1 with opposing handles 8 was old and well known in the art at the time the invention was made. See Figure 2. From the teaching of Karashima, providing the wheeled item/scooter of Lamson with opposing handles would have been obvious to one of ordinary skill in the art at the time the invention was made. This would allow a user to efficiently grip the wheeled item/scooter.

Also, the claimed dimensions are not disclosed as being critical. In fact, on line 39 of page 6 through line 1 of page 7 of the specification Applicant states that the sled "can be shaped and sized as desired" and that the sled "can be essentially any shape and size".

The claimed dimensions are merely an optimization of the size of the sled of Lamson that would have been ascertained by one of ordinary skill in the art through routine experimentation. Forming the dimensions of the sled as claimed would have been obvious to one of ordinary skill in the art at the time the invention was made in order to appropriately size the sled for a particular user or a particular application.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamson US 4,458,906 in view of Karashima US 6,095,348 as applied to claim 18 above, and further in view of Bergsland US 3,705,730.

Lamson, as modified by Karashima, does not disclose a connector at the first end of the body and a connector receptor at the second end of the body. However, Bergsland teaches that the practice of providing a toy sled with a connector 5 at a first

Art Unit: 3618

end of a body and a connector receptor 3 at a second end of the body was old and well known in the art at the time the invention was made. See Figures 1 and 2. From the teaching of Bergsland, providing the sled of Lamson with a connector at the first end of the body and a connector receptacle at the second end of the body would have been obvious to one of ordinary skill in the art at the time the invention was made. This would allow the sled to be formed into a train with other sleds.

Allowable Subject Matter

Claims 11 and 13-17 are allowed. Claim 11 defines the first and second attachment mechanism receptacles centrally positioned in the first and second scooter engagement recesses respectively. These features, in combination with the further features defined by the claims, distinguish the claimed invention over the prior art.

Response to Arguments

Applicant's arguments filed October 10, 2003 have been fully considered.

In regard to claim 1 and claims 2, 3, and 6-10, which depend from claim 1, Applicant asserts that Lamson does not have a handle defined by and planar with the body. However, the side edges, forward edge, and rear edge of the body form handles, and those handles are generally planar with the top surface and the bottom surface as claimed. The term "planar" in the claims merely requires that the handles formed by the edges lie in a plane that has some relationship to the top surface and bottom surface. Each edge does lie in a plane that has a relationship to the top and bottom surfaces.

Art. Unit: 3618

Moreover, the term "generally" indicates that the handles do not even have to lie in a plane, they only have to have some relationship with the top and bottom surfaces. Each edge of Lamson does have such a relationship with the top and bottom surfaces. Also, the shape of the wheeled item is obvious, as stated in the rejection above.

The arguments presented in regard to claims 18-22 are moot in light of the new terms of rejection outlined above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3618

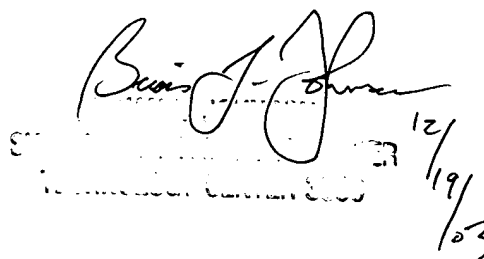
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher Bottorff



12/19/03